

REMARKS

This is in response to the official action dated October 23, 2008. Reconsideration in view of the following is respectfully requested.

All pending claims stand rejected over the primary reference Canadian application no. 2014775 (“CA 775”). CA 775 discloses a borated ester compound. An amide compound is prepared by reacting a fatty acid with mono or diethanolamine in equimolar amounts (*1:1 molar ratio*), and such amide compound is then reacted with boric acid to form a N-(2-hydroxyethyl) amide. A preferred resulting amide compound is formed by reacting 9-octadecenoic acid with monoethanolamine to form N, N'-bis(2-hydroxylethyl)-9-octadeceneamide. The amide is then borated by reacting with boric acid.

In contrast, applicant’s invention starts out with the reaction product prepared by reacting a fatty oil with diethanolamine (*1: 1.8 molar ratio*). The resulting reaction product is then reacted with boric acid. A preferred fatty oil may be coconut oil.

The examiner appears to take the position that the teaching of CA 775 and that of the present invention is the same as regards the preparation of the borated ester. The examiner states that the reaction of fatty oil and diethanolamine is “clearly taught” by CA 775. This is not the case, as nowhere does CA 775 teach or suggest a fatty oil as a reactant. A fatty oil and a fatty acid are not the same, the molar ratio of the reactions are clearly different, and accordingly, the resulting compounds are not the same.

While this alone is sufficient to demonstrate that CA 775 could not possibly contemplate the present invention, applicant has also prepared comparative data between a composition

Application No. 10/678,408

formed according to the present claims and a composition taught by CA 775. As set forth in the attached Rule 132 Declaration, it is seen that the claimed borated compound, being a reaction of boric acid with a starting compound which is itself the reaction of a fatty oil and diethanolamine, is far superior in terms of antiwear protection than the prior art CA 775 compound, when each were combined with ZDDP.

Therefore, CA 775 does not teach, nor contemplate, a lubricant having as primary component a composition formed as a borated version of the reaction product of a fatty oil and diethanolamine. While applicant submits that there would have been no motivation to use fatty oil in place of fatty acid in producing the material to be reacted with boric acid, in any event it is surprisingly demonstrated that the fatty oil-based compound shows superior antiwear characteristics which could not have been foreseen.

While the examiner has issued further rejections based on combinations of CA 775 with secondary references, none of those references remedies the deficiency of CA 775 as set out above. Accordingly, all claims are allowable over the cited prior art.

Respectfully submitted,
NORRIS MC LAUGHLIN & MARCUS, P.A.

By

Bruce S. Londa

Reg. No. 33,531

875 Third Avenue, 18th Floor

New York, New York 10022

Phone: (212) 808-0700

Fax: (212) 808-0844